

SMART & BIGGAR



Webinar

What every in-house counsel needs to know about Intellectual Property law.

Wednesday, May 27



Speakers

Moderator



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About Smart & Biggar

- Smart & Biggar and Fetherstonhaugh & Co. : sister firms, founded in 1890
- New name in 2019! >> Smart & Biggar LLP and Smart & Biggar IP Agency Co.
>> **Smart & Biggar**
- Canada's largest law firm for IP and technology
- Offices across the country: Ottawa, Montreal, Toronto, Calgary and Vancouver
- Over 100 professionals
- Expertise in all areas of IP, including trademarks, patent, copyright, industrial designs and litigation



Misconceptions of IP

Andrea Pasztor



Best Misconceptions
about IP I've heard so far:



“Copyrights, patents, trademarks and trade secrets are all kind of the same thing”
or the “*Copytrademarent*”

Clients know of the words, but do not always know what they mean; therefore, having some knowledge of each type of IP and a simple way to communicate to clients will be an asset;

No need to know whether something is patentable / registerable (there are experts for that) but helpful to know what type of IP is being worked on and help guide the client.

“IP is Marketing’s problem”

IP is not one person in an organization’s burden or opportunity;

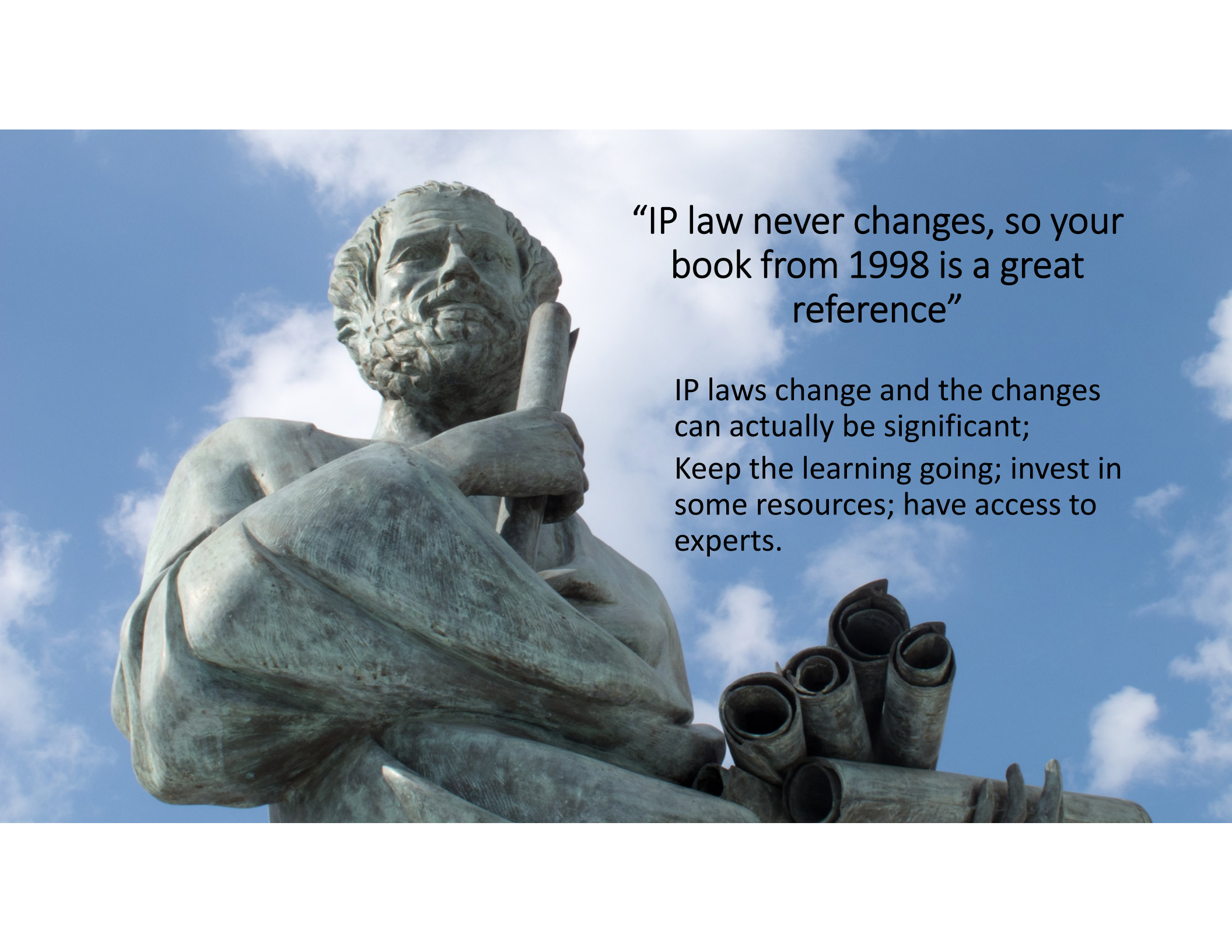
IP takes a village:
management, legal (internal and external), marketing, sales, procurement, authors/designers/inventors, employees, etc.





“We’ll just make up the IP
stuff up as we go”

There are benefits to good internal
IP policies and strategies...
...especially before there is a
problem.



“IP law never changes, so your
book from 1998 is a great
reference”

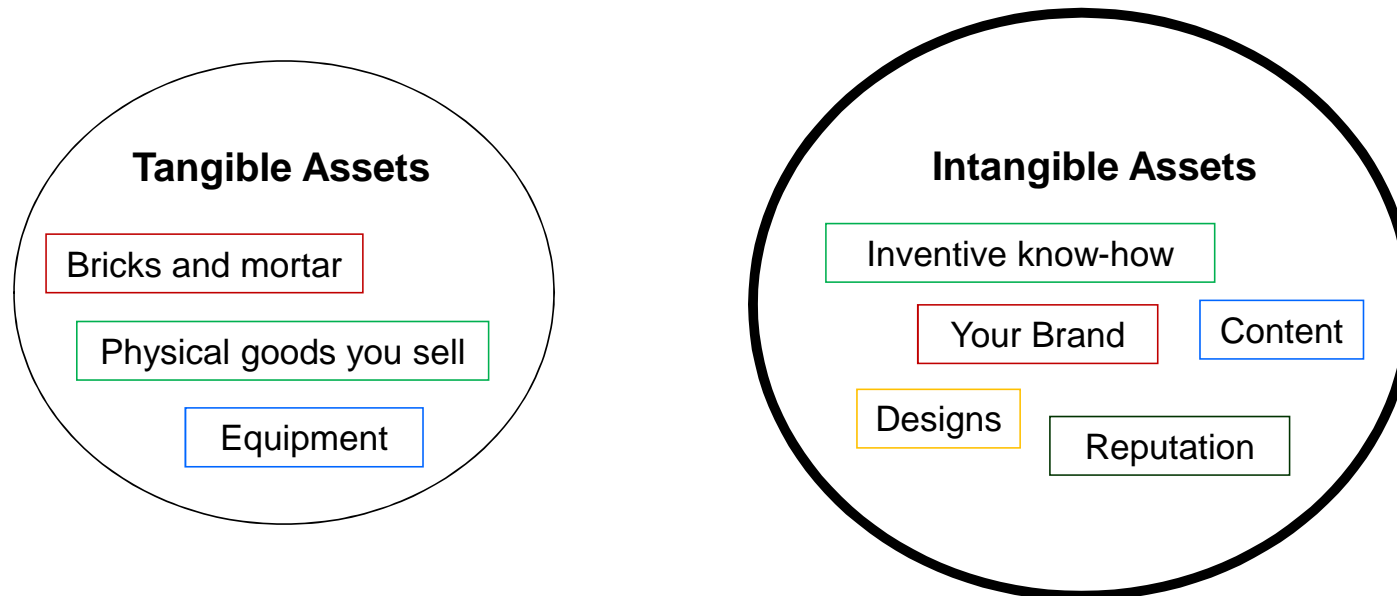
IP laws change and the changes
can actually be significant;
Keep the learning going; invest in
some resources; have access to
experts.



Brands and Copyright

Daniel Anthony

Business assets



“Some two-thirds of the value of America’s large businesses can be traced to the intangible assets that embody ideas, especially the intellectual property (IP) of patents and trademarks”

- *Economic Effects of Intellectual Property-Intensive Manufacturing in the United States* by Economists Robert J. Shapiro and Nam D. Pham July 2007 (http://www.sonecon.com/docs/studies/0807_thevalueofip.pdf)

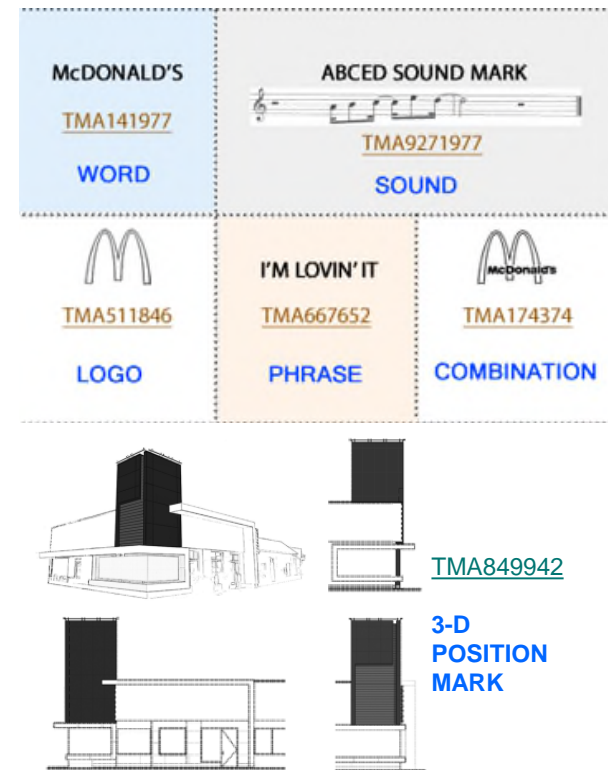
What's in a Brand?

- Brands represent your name, your promise, your calling card and your reputation, all rolled into one.
- Brand tap into a consumer's emotions, converting commodity into value.
- Building strength and value in a brand takes time and effort.



Brands are anchored by TMs

- **Trademark:** Something that, in the eyes of the consumers, points to a single source of services/products and distinguishes them from the services/products of others
- **Strength:** The more a trademark is unique, used, promoted and advertised, the more recognizable it becomes and the stronger it points to the source



Types of TM Protection

Words

MCNUGGETS

Sound



Roar

Designs



Packaging for Goods



Three-Dimensional Shapes

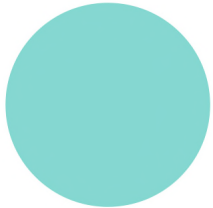


Colour and Contour



New Types of Trademark Protection

Colour *per se*



Holograms



Texture



Scent



Taste



Moving Images











Benefits of a Registration

1. Risk Management
2. Tool for passive blocking
3. Tool for active enforcement
4. Generates and holds value
5. Leverage

Apple still the most valuable brand in the world, name now worth 9% more

Oct. 18th 2019

01  +9% 234,241 \$m	02  +8% 167,713 \$m	03  +24% 125,263 \$m	04  +17% 108,847 \$m
05  -4% 63,365 \$m	06  +2% 61,098 \$m	07  +5% 56,246 \$m	08  +5% 50,832 \$m

Basic Guidance for TM use

- Use Marks in a **consistent** manner
- Marks must **stand out**
- UnregisteredTM v. Registered®
- Always use as an **adjective**
- Always use in the **singular**
- Distinguish corporate name from mark
- Provide notice of **ownership**
- Ensure that use by others is **licensed** and provide for **control**
- Don't forget about domains, handles, etc.

Copyright

- **Copyright:** The exclusive legal right to produce or reproduce a work or any substantial part in any material form whatever
 - **Literary** – brochures, websites, code, manuals
 - **Artistic** – logos, pictures, sculptures, plans
 - **Musical** – composition and songs
 - **Dramatic** - videos



Key tips on copyright

- Arises automatically and globally (but ownership is tricky)
- Applies to “original” works that are “fixed” and avoid excluded subject matter
- Lasts a long time! - 50 years past death of last author
- Fair dealing limitations are very limited
- Notice is easy – © 2019 Smart & Biggar
- Consider protection measures

Elements of a Model Strategy

- **Ownership** – Licensing and control for TMs; assignments for copyright
- **Clearance** – Risk management, avoid complaints, ensure brand future
- **Use** – use it or lost it, use is king for TMs (not critical for copyright)
- **Protection** – register key marks and copyrights, give notice (marking)
- **Monitoring** – track your use, competitor's use, infringers, media
- **Enforcement** – triage and take action, watch or drop

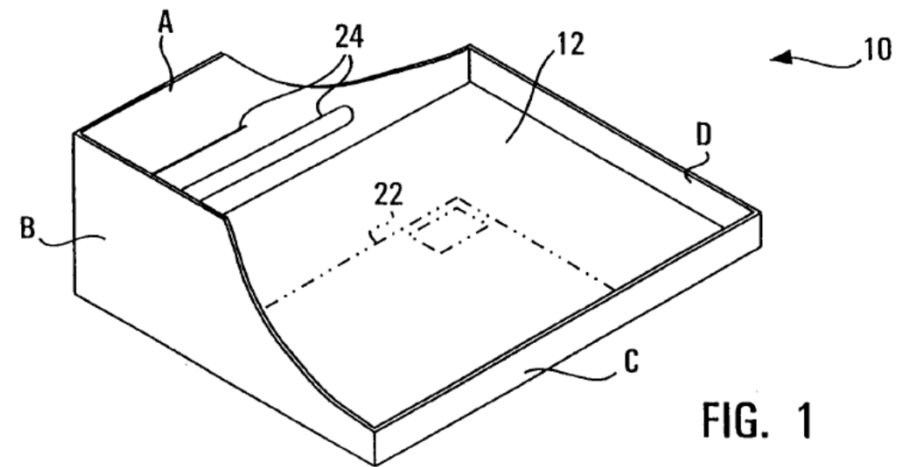


Patents & Designs

Lionel Fishman

Patents – The Basics

- Protect inventions
- For example: new and inventive products, processes, methods, systems, materials...
- Must be applied for in every country where protection is desired
- Term: 20 years



CA Patent No. 2245475 for
Package Size Gauge

Designs – The Basics

- Protect appearance
- For example: novel shapes, patterns, configurations, GUIs, animations...
- Must be applied for in every country where protection is desired
- Term: 15 years



Juicy Salif Citrus Squeezer



Key Issues - Ownership and Inventorship

- Inventor distinct from owner
- Employment agreements
- Co-development agreements
- Supplier/service contracts
- Assignments



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Key Issues – Navigating the Landscape

- What rights do our competitors have?
- Are we infringing their rights?
- Can we work around their rights?



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Key Issues - Obtaining your own Rights

- What is our strategy?
- Disclosure and Timing
- Internal processes



Key Issues– Extracting Value

- Enforcement
- Property
- Valuation
- Tax Strategy





Questions?



Thank you

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